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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,853	01/22/2004	Robert Sesek	200206923-1	5874

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EXAMINER

WILLIAMS, JAMILA O

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,853

Applicant(s)

SESEK ET AL.

Examiner

Jamila O. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/22/04
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, 20-24, drawn to "A photography guidebook" or "A system", classified in class 281, subclass 38.
- II. Claims 14-19, drawn to "A method of photographing a subject", classified in class 396, subclass 661.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the guidebook and system claimed can be used in a process to take photographs and mount in the guidebook without retrieving photograph details from the guidebook.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with James McDaniel on 8/10/2006 a provisional election was made without traverse to prosecute the invention of group 1, claims. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 20 it is unclear what is encompassed by the following phrases: "means for retrieving photograph details in a guidebook, means for navigating to a photograph taking location, means for orienting a camera according to the retrieved photograph details, means for photographing a subject once the camera is oriented". Applicant needs to clarify what is meant by the "means for" limitations and how they further limit the guidebook being claimed.

In claim 22, it is unclear how the limitation "using a camera that allows for the reproduction of the photograph details" further limits the guidebook. This recitation appears to be a method step but the preamble of claim 20 (from which claim 22 depends) recites a product (a guidebook).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over 4,965,948 to Ruebens.

Ruebens discloses a photography guidebook comprising a plurality of blank photograph locations (22) and a plurality of writing surfaces (34) with indicia imprinted thereon (35,36).

Ruebens discloses the claimed invention except for the specific arrangement and/or content of the indicia (printed matter) set forth in the claims (i.e. photograph descriptions including one or more of camera location, coordinates, magnetic bearing of the lens, inclination of camera, shutter speed, an aperture, a plurality of environmental conditions, film type, recited in claim 2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to alter the indicia since it would only depend on the intended use

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of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401 (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information/instruction does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (photograph descriptions) and the substrate (guidebook) that is required for patentability.

Regarding claims 3-4, Ruebens discloses that the descriptions are placed in a portion of the guidebook separate from the photograph locations, the descriptions are placed adjacent their photograph locations (see figure 1 for example).

Regarding claim 5, Ruebens discloses that the descriptions comprise a caption for the photograph and a set of technical details of the photograph locations (see figure 1 and the *In re Gulack* rejection above).

Regarding claim 6, Ruebens discloses that the technical details are placed in a portion of the guidebook separate from the photograph locations and captions (figure 1).

Regarding claims 7-9 see rejections of claims 1-3 above.

Regarding claims 20-22, (as best understood in view of the 112 above), Ruebens discloses a guidebook for taking photographs comprising the means claimed.

Claims 10-13 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over D468,350 to Sussman et al (hereinafter Sussman) or 6,257,621 to Smith in view of 965,948 to Ruebens. Both Sussman and Smith disclose a system comprising a camera and guidebook having a plurality of blank photograph locations (see claim and figure 2 of Sussman which appears to show a camera mounted in the front cover and a plurality of pages with photos mounted thereon; see fig 1 and column 3 lines 50-53 of Smith)

Neither Sussman nor Smith show a plurality of photograph descriptions of the blank photograph locations.

Ruebens teaches having indicia associated with the photos (35,36).

Regarding the specific arrangement and/or content of the indicia (printed matter) set forth in the claims (i.e. photograph descriptions including one or more of camera location, coordinates, magnetic bearing of the lens, inclination of camera, shutter speed, an aperture, a plurality of environmental conditions, film type recited in claim 11), it would have been obvious to one having ordinary skill in the art at the time the invention was made to alter the indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401 (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information/instruction does not alter the functional relationship. Mere

support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (photograph descriptions) and the substrate (guidebook) that is required for patentability.

Regarding claim 12, Sussman or Smith (modified by Ruebens) discloses the descriptions are placed in a portion of the guidebook separate from the photograph locations (figure 1 of Ruebens).

Regarding claim 13, Sussman or Smith (modified by Ruebens) discloses the descriptions are placed adjacent their respective photograph locations (figure 1 of Ruebens).

Regarding claims 23-24, Sussman or Smith (modified by Ruebens) discloses the system comprising a guidebook having a plurality of photograph locations and technical details for identifying each of the blank photograph locations (figure 2 of Sussman, figure 1 of Smith, figure 1 of Ruebens) and means for replicating the technical details (camera of Sussman or Smith).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O. Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday-Friday 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-3484. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JW 8-9-2006



MONICA CARTER
SUPERVISORY PATENT EXAMINER